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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,116	07/26/2001	Bruce E. Price	RGP-0062	8624

23413 7590 07/16/2004

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EXAMINER	
CHANG, VICTOR S	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,116	PRICE ET AL.	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19 and 34-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19 and 34-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner has carefully considered Applicants' declaration, amendments and remarks filed on 5/25/2004. Applicants' amendments to claims 1, 13, 17, 35 and 37 have been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 1-19 and 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that all the independent claims 1, 13 and 17, line 2 of each claim, have been amended to recite "configured for flexographic printing". The Examiner respectfully notes that the term "configured" appears to be either vague and indefinite, because it imparts no structural definition yet implies something is done, or unnecessary as the structural relations of the claimed elements are already clearly recited in each claim. Additionally, if the aforementioned phrase is intended to state the "use" of the claimed invention, then the Examiner suggests that incorporating the phrase "for flexographic printing" into the preamble appears to be more appropriate. Clarification is requested.

Response to Amendment

5. Claims 1-19 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admission in view of Birchall et al. (US 3839078), substantially for the reasons set forth in section 4 of Office action mailed 11/25/2003, together with the following additional observations, together with the following additional observations.

It is noted that newly amended independent claims 1, 13 and 17 now recite "configured for flexographic printing", and the term "configured" appears to be vague and indefinite, as set forth above. Since the structural relationship of the claimed elements have already been clearly recited, the term "configured" has not been given any patentable weight. Additionally, it should be noted that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicants after the Examiner presents an otherwise *prima facie* rejection. See MPEP § 2113.

Similarly, with respect to newly added recitation in claims 1, 13 and 17, "wherein the first side of the anchoring layer is disposed on the first side of the reinforcing layer ...", the Examiner again notes that Applicants must show that the resultant article is patentably distinct from those taught by the reference, since the method of forming the device is not germane to the issue of patentability of the device itself, as set forth above.

With respect to Applicants' argument "In view of the fact that there is clearly no need improve the adhesion between the laminate layers in the presently claimed flexographic tapes, Applicants respectfully disagree that the foregoing would have provided sufficient motivation to one ordinary skill in the art." (Remarks, page 7, bottom paragraph), the Examiner repeats (see Office action mailed 11/25/2003) that Birchall teaches that it has been a common practice to coat a surface of a film substrate with one or more adhesion promoting layers which adhere to the film substrate and to which the superstrate readily adheres. As such, it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior art with an anchor layer, as a common practice, between the reinforcing film substrate and the polyurethane foam layer, motivated by the desire to improve the adhesion between the laminate layers (see page 4 of Paper No. 6), Applicants' argument to the contrary notwithstanding.

The declaration by Mr. Brett Kilhenny, dated 5/25/2004, and Applicants' repeated argument "failure to cleanly remove a polyurethane foam-containing flexographic tape is due to cohesive failure in the reinforcing layer, not the bond failure between the foam and the reinforcing layer. Since an improvement in bonding strength is not needed in the manufacture of flexographic tapes comprising polyurethane foams, addition of an anchoring layer as suggested by the Examiner represents unnecessary expense and manufacturing time. One of ordinary skill in the art would therefore not have been motivated to provide flexographic tapes made using polyurethane foams with the anchoring layer of Birchall." (Remarks, pages 7-8, bridging paragraph) have been carefully considered, but is not persuasive. First, the Examiner repeats (see Advisory

mailed 7/24/2003) that since Birchall teaches all the elements of the "anchor" layer of the instantly claimed invention, it is believed that the improved cohesive strength in the surface region of the substrate by the "anchor" layer is also inherently disclosed by Birch. It should be noted that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. MPEP 2145, II. Second, it appears that Applicants' argument "an improvement in bonding strength is not needed" clearly contradicts the claimed elements being an adhesively laminated product. The Examiner repeats (see Office action mailed 11/25/2003, page 3, top paragraph) that it would have obvious to one of ordinary skill in the art of a laminate to incorporate Birchall's teaching to in the admitted known flexographic tapes, motivated by the desire to obtain a durable laminate by improving the adhesion between the laminate layers. Finally, the Examiner notes that the cost of the manufacture bears no weight in patentability.

With respect to Applicants' argument that "The fact that both Birchall and the present application refers to "anchor" layers does not mean that these layers have the same function." (Remarks, page 8, first full paragraph), the Examiner notes that Birchall's anchor layer reads on the instantly claimed anchor layer as claimed (both in structure and composition), and again repeats that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention, as set forth above.

With respect to Applicants' argument "the anchor layers of Birchall are not used for the same purpose as the presently claimed anchor layers." (Remarks, page 8,

second full paragraph), the Examiner repeats (see Office action mailed 11/25/2003, page 3, top paragraph) Applicants' admitted prior art and Birchall are both directed to the same field of invention, i.e., an anchor coating to promote adhesion between a film substrate and superstrate. As such, Applicants' admitted prior art and Birchall are combinable.

With respect to Applicants' argument that "the Examiner has used an improper hindsight that fails to consider the totality of the invention and the totality of the cited references." (Remarks, page 8, bottom paragraph), the Examiner notes that Birchall expressly teaches that it has been a common practice to coat a surface of a film substrate with one or more adhesion promoting layers which adhere to the film substrate and to which the superstrate readily adheres. As such, it would have been well within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicant's disclosure, and it is believed that such a reconstruction is proper, Applicants' argument to the contrary notwithstanding.

With respect to Applicants' argument that "Birchall is ... directed to "organic plastic film" and not polyurethane foams as is presently claimed. Birchall further fails to disclose the specific materials required in claims 20 and 22 ...", the Examiner notes that Birchall's teaching clearly reads on instantly claimed "reinforcing film" in independent claims 1, 13 and 17; further, claims 20 and 22 have been cancelled.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC

Victor S Chang
Examiner
Art Unit 1771

7/11/2004

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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